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R E M A R K S

Prior to entry of this Amendment:

- Claims 1-29 were pending in the present application
- Claims 1-29 stand rejected

Upon entry of this Amendment:

- Claims 1-29 and 72-91 will be pending
- Claims 72-91 will be added
- Claims 1 and 21 will be the only independent claims

Section 103(a) Rejection

Claims 1-15 and 18-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,814,589 issued to Storch ("Storch") in view of U.S. Patent No. 5,895,321 issued to Gassies, et al. ("Gassies"). Claims 16-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Storch in view of Gassies and further in view of U.S. Patent No. 5,361,885 issued to Modler ("Modler"). Applicants respectfully traverse all of the Examiner's Section 103(a) rejections.

1. No teaching or suggestion of all the features of any of Claims 1-29

As discussed in the Response mailed February 7, 2002, Applicants respectfully submit that the Storch, Gassies and Modler references, either alone or in combination, do not teach or suggest features generally directed to:

in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value

as recited in independent Claim 1; or

means, responsive to said detecting means, for associating a second non-zero value with said one of the gaming tokens, the second non-zero value being different from the first non-zero value

as recited in independent Claim 21.

Neither Storch, Modler nor Gassies, alone or in combination, suggests any benefit of affecting the value of a gaming token, much less when a value of a gaming token should be changed. With respect to independent Claims 1 and 21, the Examiner asserts that the "coding system" of Storch "can be employed for enabling positive real-time event detection..." and comprises "means for comparing stored identifying information with the received information to detect if one or more items are encoded with the same information thereby detecting counterfeits." Office Action, pages 2-3. However, Applicants respectfully submit that neither Storch, Modler, nor Gassies, alone or in combination, teaches or suggests associating a second non-zero value with a gaming token in response to detection of a counterfeit, or in response to any other event. Accordingly, the cited references cannot teach or suggest a feature generally

directed to *associating a second non-zero value with a gaming token in response to the detection of an event*, as recited in independent Claims **1 and 21**. Contrary to the Examiner's assertion, therefore, the proposed combination of Storch and Gassies does not provide for all of the limitations of independent Claims **1 and 21**. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent Claims **1 and 21**, and Claims **2-20 and 22-29** dependent respectively therefrom.

The Examiner also merely asserts that it was "known" or "well-known" that various types of events may be detected "in a lot of ways." Office Action, page 3. The Examiner's rejection of Claims **4-11 and 26-29** is thus based in part on unsupported general assertions of what was "known" or "well known" before the time of Applicants' invention. Because the Examiner did not provide a reference, Applicants assume that the Examiner intended to take Official Notice of this asserted subject matter. Applicants respectfully traverse this assertion as an improper factual finding, because it is a mere conclusion without any support in the record. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statement, Applicants cannot properly determine the bounds of the prior art. Applicants also respectfully request that this use of Official Notice be supported by a reference, so that Applicants may better assist the Examiner in examination of the claims. Per MPEP 2144.03, the burden is on the Examiner to provide a reference once such a request has been made. Specifically, a reference must be provided to show the scope and content of the prior art.

However, even if the detection of such events was "well-known," which Applicants respectfully dispute, the Examiner does not present a reasoned finding that any of the cited references suggests either (i) changing the value of a gaming token in response to detection of any of the asserted types of events, or (ii) the desirability of such a feature. As there is no teaching or suggestion in either Storch, Modler, or Gassies, alone or in combination, of associating a second non-zero value with a gaming token in response to the detection of any event, the cited references cannot teach or suggestion such *associating in response to the detection of any of*:

- insertion of the gaming token in a gaming device (Claims 4 and 27);*
- a period of time that a player has played a gaming device (Claim 6);*
- a number of times that a player has played a gaming device (Claim 8);*
- discharging of the gaming token from a gaming device (Claims 10 and 28); or*
- placing the gaming token in proximity to a value-changing device (Claim 12).*

The Examiner does not assert that the cited references suggest associating a second non-zero value with a gaming token *in response to* the detection of any such events. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claims **4, 6, 8, 10, 12, 27, and 28**, and any claims dependent therefrom.

Further with respect to Claims **12 and 13**, the Examiner does not assert that any of the cited references teaches or suggests a *value-changing device*, but makes a brief reference to an unspecified "capability of reprogramming those chips" of Gassies. Applicants have carefully reviewed Gassies and have been unable to identify a described device for "reprogramming those

chips,” much less *a value-changing device*, much less associating a second non-zero value with a gaming token *in response to placing the gaming token in proximity to a value-changing device* (as recited in Claim 12), much less *wherein the value-changing device includes magnet means* (as recited in Claim 13). Various embodiments of the present invention provide for wherein a detected event may be placing the gaming token in proximity to a value-changing device, such as a read/write device that may be actuated by a dealer to change the value of the gaming token. Such a device may include, for example, a mechanism for changing a magnetic state of a component of the gaming token. See, e.g., Specification, page 2, lines 20-26. Applicants respectfully submit that the cited references are devoid of a hint or suggestion of *a value-changing device*, as recited in each of Claims 12 and 13. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claims 12 and 13.

Further with respect to Claim 17, Applicants have carefully reviewed Modler, including the passage cited by the Examiner, but have been unable to identify a teaching or suggestion in Modler of *a display device mounted on a gaming token*, as recited in Claim 17. Applicants respectfully request that the Examiner clarify the rejection of Claim 17 in light of the cited references. Applicants respectfully submit that none of the cited references teaches or suggests *displaying at least one of the values of the gaming token via a display device mounted on a gaming token*, as recited in Claim 17. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claim 17.

2. No motivation to combine the cited references

There is no suggestion or motivation, in either the cited references (Storch, Gassies, and/or Modler), in the knowledge generally available to one of ordinary skill in the art, or in the problem to be solved, to modify or to combine the cited references to provide for all of the claimed features of independent Claims 1 and 21.

The Examiner asserts that it would have been obvious “to incorporate the reprogrammable device of Gassies into the Storch type device in order to modify and allow changes to be made when needed.” Applicants respectfully traverse this assertion.

Applicants respectfully submit that it would not have been obvious to embed a reprogrammable device as described in Gassies into the gaming chip described in Storch art. For example, all of the information described for use in the Storch system is encoded on the periphery (i.e., not the face) of a gambling chip:

Racks currently in use for holding gambling chips arrange the chips in a stack or a column...with a substantial portion of the periphery of the chips exposed so the chips can be visually observed and handled without difficulty. Hence, only the chip peripheries are exposed or otherwise accessible for reading coded information since the faces of adjacent chips are typically not separated from each other and, therefore, are not accessible for reading coded information.... Thus, it was concluded that coded information should be obtained from only a part of a chip periphery....

Column 6, lines 1-36. Gassies, in contrast, describes an electronic device “embedded in a protective wafer of synthetic resin” in “an internal central region” of a gambling chip. Column 1, lines 61-67. The Examiner’s proposed combination provides for the gaming chip described in

Storch, having the necessary information encoded on the periphery, to include an embedded electronic device. Such a modification would add unnecessarily to the complexity of the Storch system.

The Examiner also does not indicate any evidence of record supporting the Examiner's assertion that it would have been obvious to make the proposed combination. In particular, "to modify and allow changes to be made when needed" is merely an asserted benefit of the Examiner's proposed combination, without support in the record. Gassies only briefly describes "a reprogrammable device having a changing code with the possibility of reading and writing in memory" (Column 4, lines 59-60), but there is no teaching or suggestion in the cited references of any benefits or uses of such "possibility," much less a need for, or the desirability of, allowing changes to a token's value "to be made when needed." Further, there is no suggestion in the prior art of record of when such a change to a token's value might be "needed" or even desirable. Accordingly, there is no support in the cited references for the Examiner's asserted motivation "to incorporate the reprogrammable device of Gassies into the Storch type device."

Also, as discussed above, the proposed combination of Gassies and Storch would not provide for all of the features of any of independent Claims **1 and 21**. Applicants respectfully submit that there is no motivation in the evidence of record to combine the Storch and Gassies references in order to provide for a feature generally directed to *associating a second non-zero value with a gaming token in response to detection of an event*. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claims **1 and 21** (and Claims **2-20 and 22-29** respectively dependent therefrom).

Also, Modler explicitly teaches away from the Examiner's proposed combination of Gassies, Storch and Modler. Specifically, Modler teaches away from the use of electronic devices in a gaming chip: "[T]he implementation of...small computer chips in gaming chips is impractical because the computer chips are destroyed by the high temperatures used in forming typical plastic gaming chips." Column 1, lines 27-32. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of Claims **16 and 17**.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of the pending claims (Claims **1-29**). Applicants respectfully submit that Claims **1-29** contain allowable subject matter.

New Claims 72-91 Are Allowable

New Claims **72-91** have been added. All of Claims **72-91** are dependent from independent Claim **1**, and are believed to be allowable for at least the reasons stated herein with respect to independent Claim **1**.

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Petition for Extension of Time to Respond


Applicants hereby petition for a ONE-month extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

May 1, 2003

Date



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